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In re Application of :
BASSET, Jean-Claude :
U.S. Application No.: 09/980,355 :
PCT No.: PCT/FR00/01463 :
Int. Filing Date: 29 May 2000 :
Priority Date: 02 June 1999 :
Attorney's Docket No.: SCP061792 :
For: DIGITAL-TELEVISION :
RECEIVER/DECODER DEVICE WITH :
PLAYBACK . . . :

DECISION

The decision is in response to the papers submitted on 25 July 2002.

BACKGROUND

On 09 November 2001, applicant filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, authorization to charge the basic national fee.

On 01 April 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee pursuant to 37 CFR 1.492(e) was required. Applicant was given two months to respond with extensions of time available pursuant to 37 CFR 1.136(a).

On 25 July 2002, applicant submitted the instant petition under 37 CFR 1.47(b) which was accompanied by, *inter alia*, the surcharge fee of \$130.00; a two-month extension and \$400.00 fee; the petition fee of \$130.00; a Declaration of the 37 CFR 1.47(b) applicant; and various documents titled Exhibits A-F.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the sole inventor refuses to sign or cannot be reached after diligent effort, (3) a statement of the last known address of the inventors, (4) an

oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventors, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. Applicant has completed items (1) and (3).

Regarding item (1), the appropriate petition fee has been paid.

Concerning item (2), section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) explains that:

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has submitted copies of e-mail messages with accompanying English translations between Mr. Basset and the 37 CFR 1.47(b) applicant as well as copies of two registered letters sent to Mr. Basset. This evidence shows that Mr. Basset received a copy of the U.S. application along with a transfer document and a declaration to sign. Due to the lack of response from Mr. Basset, petitioner concludes that a "diligent effort has been made to obtain Mr. Basset's signature, and that Mr. Basset has refused to sign and return the required documents." Pet. at ¶ 1. This evidence is sufficient to satisfy item (2).

Concerning item (3), the last known addresses of the sole inventor, Jean Claude Basset is listed as:

84 rue Vergniaud
F-75013, Paris
France

With regards to item (4), the petitioner has submitted a Declaration signed by Joseph S. Tripoli for the 37 CFR 1.47(b) applicant, Thomson Multimedia Licensing Inc. Section 409.03(b) of the MPEP states, in part:

The 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.64 or 1.175. Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath

or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation.

In this case, petitioner states that "Joseph S. Tripoli is authorized to sign requisite documents concerning this patent on behalf of Thomson Multimedia Digital France." *Id.* at ¶ 11. The declaration included the sole inventor's name, last known address, residence and citizenship and is in compliance with 37 CFR 1.497(a) and (b). Therefore, item (4) is satisfied.

With regard to item (6), section 409.03(g) of the MPEP states that "[i]rreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage." Here, petitioner states that "a declaration . . . is hereby submitted to satisfy the requirement of the Notification and to preserve the rights of Thomson Multimedia Digital France in the present application." This is sufficient to satisfy item (6).

However, the petitioner failed to satisfy item (5) of 37 CFR 1.47(b). Section 409.03(f) of the MPEP discusses the ways to show sufficient proprietary interest and states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that:

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324).

Petitioner claims that "[a]pplicant has proprietary rights in the present application

as a result of the transfer from Dassault Automatismes et Telecommunications S.A." Id. at ¶ 10. Petitioners submitted an assignment document (in French with accompanying English translation) as Exhibit E, showing that Daussault Automatismes et Télécommunications SA assigned the rights of the French patent No. 99 06957 claimed as a priority in PCT/FR00/01463 to the 37 CFR 1.47(b) applicant. However, petitioners have not provided any evidence disclosing how Dassault Automatismes et Telecommunications S.A. originally obtained the rights of the patent from the sole inventor, Mr. Basset, nor has petitioner shown that they have acquired rights in the PCT application. The PCT application is not listed in the supplemental assignment. Moreover, petitioner has also not shown that the disclosure of the priority document is the same as the present application. The 37 CFR 1.47(b) must show a clear chain of title from the sole inventor to the 37 CFR 1.47(b) applicant. In addition, a statement under 37 CFR 3.73(b) is also required. *See above.*

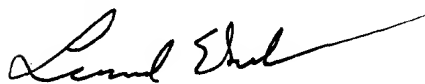
It is also noted that the statement by Mr. Basset in the e-mail dated 10 January 2002 that he does not "dispute TMM's rights in respect of these patents" is not dispositive of the patent rights in the invention. Mr. Basset may or may not be aware of his legal rights pertaining to the above-referenced patent application. There is no way to tell from the evidence submitted. For all of these reasons, item (5) of 37 CFR 1.47(b) is not satisfied. Since petitioner failed to meet item (5), it is not appropriate to accept this application under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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